

REMARKS

Applicant appreciates the Examiner's thorough consideration provided the present application. Claims 1-4, 8, 11-13, 16-18 and 22 are currently pending in the instant application. Claims 5-7, 9, 10, 14, 15 and 19-21 have been cancelled. Claims 1 and 8 have been amended. Claims 1 and 22 are independent. Claim 22 has been added for the Examiner's consideration. Reconsideration of the present application is earnestly solicited.

Drawings

The drawings have been objected to as allegedly failing to comply with 37 CFR 1.84(g) as indicated on the PTO-948. This objection is respectfully traversed.

Applicant has filed formal drawings of FIG. 10 and FIG. 11 concurrently herewith that addresses the Examiner's requested changes. Accordingly, this objection has been obviated and/or rendered moot.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 3, 11, 13, 16, 18 and 21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kubo et al. (U.S. Patent No. 5,828,461). This rejection is respectfully traversed.

Claim 1 has been amended to include features of cancelled claim 5. In addition, claims 5-7, 9, 10, 14, 14 and 19-21 have been cancelled. In light of

the foregoing amendment to the claims, this rejection has been obviated and/or rendered moot.

The prior art of record fails to teach or suggest each and every element of the combination of elements of the claimed invention. Specifically, and as indicated by the Examiner, Kubo et al. fails to teach or suggest the limitation(s) of an image processing apparatus "wherein unsuitable combinations of image processings are prohibited from being executed on the image by said special image processing means, said unsuitable combinations of image processings being at least a combination of image processings from said instructing means that is mutually opposite or erroneous." (see claim 1) Accordingly, this rejection should be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 5-8, 10, 14, 15, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo in view of "Radio Buttons" by Apple Computers, Inc. (hereinafter "Radio Buttons."). Claims 2, 4, 6, 12 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo in view of Nealon (U.S. Patent No. 5,023,635). These rejections are respectfully traversed.

As aforementioned, Applicant submits that the prior art of record fails to teach or suggest each and every element of the claimed invention, including the limitation(s) of an image processing apparatus "wherein unsuitable

combinations of image processings are prohibited from being executed on the image by said special image processing means, said unsuitable combinations of image processings being at least a combination of image processings from said instructing means that is mutually opposite or erroneous." Accordingly, these rejections should be withdrawn.

The Examiner has alleged that a reference referred to as "Radio Buttons" by Apple Computers, Inc. (hereinafter as "Radio Buttons.") teaches these missing features and allegedly motivates one of ordinary skill in the art to modify the Kubo et al. device to read on the claimed invention. However, Applicant submits that the Examiner's position appears unreasonable. In addition, Applicant submits that the alleged combination of Kubo in view of Radio Buttons does not appear to raise a proper prima facie case of obviousness.

First, Applicant respectfully requests clarification as to how the Examiner made the determination that the "Radio Buttons" reference actually qualifies as prior art. Specifically, the only date listed on the copy of this reference supplied by the Examiner appears to refer to a copyright date. It has been assumed that the entire Radio Buttons reference has been afforded a July 18, 1997 publication date by the Examiner, e.g., it appears that the Examiner is relying upon the copyright date listed at the end of page 2 of the article as a publication date. The Examiner is reminded a copyright date does not necessarily equate to a publication date.

Even if the "Radio Buttons" article were valid prior art under the requirements of 35 U.S.C. § 102, it appears that this reference is completely unrelated to the claimed invention and/or that of the Kubo patent. Accordingly, one of ordinary skill in the art would not have looked to the "Radio Buttons" article as a motivation to modify the Kubo device as advanced by the Examiner and/or to cure some deficiency with the Kubo device.

For example, it does not appear that the Kubo patent and the "Radio Buttons" reference are at all related to an image processing apparatus selectively managing image processing steps. In addition, it does not appear that the Kubo patent and the Radio Buttons reference are related by any common problem. Accordingly, the "Radio Buttons" reference appears non-analogous to both the Kubo patent and the claimed invention.

The Kubo et al. patent describes a photographic image processing system 10, which includes a scanner 32, a printer 34, a PC 12, a keyboard 22 and a mouse 24 in Fig. 1 and a screen for image processing in Fig. 4. It appears that image processing is executed by designating the type of scanner and the original at the screen in Fig. 3, e.g., in advance by LUTs (Look Up Tables), etc. In Kubo et al., it is possible to change the setting using the color key button 74 in the main menu 63 (col. 20, lines 45-51).

Accordingly, Applicant requests clarification as to where the features of original claim 1 have been met by the Kubo et al. device. For example, it appears that the Examiner's position is that image processing based on the

type of scanner and the original corresponds to the necessary image processing of the claimed invention. In addition, according to the Examiner, the setting change using a color key button apparently corresponds to the special image processing of the claimed invention. Although the Examiner's position is that the Kubo patent describes the correction of a digital image based upon the use of data from LUTs (Look Up Tables, see columns 13-18 of the Kubo patent), image processing with respect to special effects processing either requested or inputted by the operator does not appear within the Kubo patent. If the Examiner persists in maintaining this rejection, Applicant requests clarification of this issue.

In addition, the radio button in the Radio Buttons reference is used only for selecting one button in a group. Therefore, the radio buttons cannot be used for image processing in which combinations of selections can be made, e.g., predetermined unsuitable combinations of image processings are prohibited from being executed on the image by said special image processing means as with the claimed invention. Accordingly, this rejection should be withdrawn.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicant respectfully submits that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application.

Accordingly, reconsideration and withdrawal of the claim rejection are respectfully requested. Moreover, the Applicant respectfully submits that the instant application is in a condition for allowance.

As to the dependent claims, Applicant respectfully submits that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

CONCLUSION

Since the remaining patents cited by the Examiner have not been utilized to reject the claims, but rather to merely show the state-of-the-art, no further comments are necessary with respect thereto.

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently pending rejections and that they be withdrawn.

In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

Applicant respectfully petitions under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a one-month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of **\$110.00** is attached hereto.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Marc S. Weiner
Reg. No. 32,181


MSW/MTS/cl

P. O. Box 747
Falls Church, VA 22040-0747
(703)205-8000

Attachment: Version with Markings to Show Changes Made

MARKED-UP VERSION OF AMENDMENTS

IN THE CLAIMS

Claim 22 has been added.

Claims 5-7, 9, 10, 14, 15 and 19-21 have been cancelled.

The claims have been amended as follows:

1. (Amended) An image processing apparatus for processing an image recorded on a recording medium, said image processing apparatus comprising:
[having]

an image reading device for reading [, as digital image data, an] the image recorded on the [a] recording medium as digital image data [, said image processing apparatus], subjecting the read digital image data to predetermined image processing, and outputting processed image data; [said image processing apparatus comprising:]

[necessary image processing] means for carrying out a necessary image processing on all of the image data read by the image reading device;

[special image processing] means for carrying out a special image processing on[, of the image data read by the image reading device, image data] the image data read by the image reading device, the special image processing being [which have been] specially designated by an operator request; and

[instructing] means for instructing the special image processing to be carried out by said special image processing means, wherein unsuitable combinations of image processings are prohibited from being executed on the

image by said special image processing means, said unsuitable combinations of image processings being at least a combination of image processings from said instructing means that is mutually opposite or erroneous.

8. (Amended) An image processing apparatus according to claim [5] 1, wherein [when an unsuitable combination of special image processings has been instructed by said instructing means,] a special image processing instructed last is given priority and a special image processing instructed first is cancelled when the unsuitable combination of special image processings has been instructed by said instructing means.